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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,693	12/06/2000	Shantha C. Nalur	8265-366	8558

28765 7590 07/28/2003

WINSTON & STRAWN
PATENT DEPARTMENT
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EXAMINER

PADEN, CAROLYN A

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 07/28/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/729,693

Applicant(s)

NALUR ET AL.

Examiner

Carolyn A Paden

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9,10,12-14,17,20,22,23,25 and 29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☒ Claim(s) 7,9,10,12-14,17 and 25 is/are allowed.

- 6) ☒ Claim(s) 1,2,4-6,20,22,23 and 29 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 7, 9, 10, 12-14, 17 and 25 are allowed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Krawczyk (5,505,982) for reasons of record and as further evidenced by Safety data for sorbitan monostearate and Seiden (3,733,210) taken together.

Krawczyk discloses co-processed cellulose surfactant made from Avicel microcrystalline cellulose and sorbitan mono-stearate in example 1. The sorbitan monostearate is stated to have an HLB of 4.7. The mixture is heated to 71.1C to keep the combination melted. One of ordinary skill in the art would have anticipated that the melting point of the emulsifier would be slightly less than 70C. In example 6 the co-processed composition is used for making chocolate.

Applicant argues that Krawczyk does not anticipate the claim because he uses a surfactant with a wide range in HLB values. This has

been considered but is not persuasive. The reference utilized emulsifiers that have the same properties as those used by applicant. Applicant argues that the reference does not show the melting point of the surfactant. In order to more precisely point out the melting point of sorbitan monostearate, examiner has provided "Safety data for sorbitan monostearate". This reference shows that the melting point of Sorbitan monostearate falls within the temperature range that is set forth in the claims. The melting point of a chemical compound is one of its critical properties and is one of the first properties measured when a new compound is discovered or invented. But sorbitan monostearate has been known for use in foods for many years, as evidenced by Seiden (3,732,210), who discusses the melting properties of emulsifiers used in his invention at column 3. Thus one of ordinary skill in the art, with at least one or two courses in college chemistry, would have recognized that the melting point of sorbitan monostearate is an inherent property of the chemical compound, which would have been known at the time of applicants invention to fall within the temperature range that is set forth in the claims.

Claims 1, 4-6, 20, 22 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Krawczyk as further evidenced by Food Ingredient Catalog.


Krawczyk discloses co-processed cellulose surfactant made from Avicel microcrystalline cellulose and a surfactant, such as monoglyceride. The emulsifiers contemplated are shown at column 2, lines 18-40 and at column 3, lines 30-67 to include distilled monoglycerides, with an HLB value of 3.8-5.3 at column 3, lines 53-54 and also a mixture of polysorbate and glycerol monostearate that has an HLB value of 4.0 at column 3, line 38. Any of these emulsifiers are disclosed to be useful with cellulose in preparing the chocolate of example 6. Thus the emulsifier in Krawczyk is disclosed to have the HLB property that is set forth in the claims. The melting point of glycerol monostearate is a property that is inherent to the compound. The melting point is generally known in the art to be measured at the time the compound is discovered or invented. Evidence for the melting point of monoglycerides is provided by "Food Ingredient Catalog" at page 27. Evidence that the melting point of glycerol monostearate is suggested to be within the range that is set forth in the claims is provided by "Handbook of Chemistry and Physics". This evidence shows that with

the melting point of the monoglyceride increases with increasing fatty acid chain length. The evidence, as a whole, suggests that the properties of melting point and HLB value were known at the time of applicants invention to be within the range of values that is set forth in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is 703-308-3294. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


CAROLYN PADEN 7-22-03
PRIMARY EXAMINER
GROUP 1300 1761